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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/587,723	04/25/2007	Jeffrey C. Miller	8325-0036.31 (S36-US3)	2253

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ROBINS & PASTERNAK  
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PALO ALTO, CA 94303

EXAMINER
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DUNSTON, JENNIFER ANN

ART UNIT	PAPER NUMBER
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1636

MAIL DATE	DELIVERY MODE
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10/04/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/587,723	<b>Applicant(s)</b> MILLER ET AL.	
	<b>Examiner</b> Jennifer Dunston	<b>Art Unit</b> 1636	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 10 August 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-14 is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 July 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

This action is in response to the amendment, filed 8/10/2010. Claims 1-14 are pending and under consideration.

#### ***Response to Arguments - 35 USC § 103***

Applicant's arguments, see pages 10-13, filed 8/10/2010, with respect to the rejection of claims 1-14 under 35 U.S.C. 103(a) as being unpatentable over Chandrasegaran in view of Smith et al, have been fully considered and are persuasive. The previous rejection of claims 1-14 has been withdrawn.

#### ***Response to Arguments - Double Patenting***

Applicant's arguments, see pages 10-13, filed 8/10/2010, with respect to the double patenting rejections based upon the application of the Chandrasegaran reference have been fully considered and are persuasive. The previous provisional rejections of claims 1-9 have been withdrawn: (i) the provisional rejection of claims 1-9 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 3-10 of copending Application No. 11/304,981 in view of Chandrasegaran has been withdrawn; (ii) provisional rejection of claims 1-9 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 6, 7, 12, 13, 18, 21, 22, 27-43, 45-51 and 55-61 of copending Application No. 10/912,932 in view of Chandrasegaran has been withdrawn; and (iii) provisional rejection of claims 1-9 on the ground of nonstatutory obviousness-type double patenting as being

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unpatentable over claims 20-27 of copending Application No. 12/456,857 in view of Chandrasegaran has been withdrawn.

This application is in condition for allowance except for the following formal matters:

***Priority***

This application repeats a substantial portion of prior Application No. 10/912,932, filed 8/6/2004, and adds and claims additional disclosure not presented in the prior application. Since this application names an inventor or inventors named in the prior application, it may constitute a **continuation-in-part** of the prior application. Should applicant desire to obtain the benefit of the filing date of the prior application, attention is directed to 35 U.S.C. 120 and 37 CFR 1.78. The present application adds disclosure related to fusion proteins comprising a zinc finger binding domain, and a cleavage half-domain, where the zinc finger binding domain is closer to the C-terminus, and the cleavage half-domain is closer to the N-terminus (e.g., Examples 25-28; Figures 43-45).

Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e) and 120 as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-

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filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 10/912,932, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application.

Application No. 10/912,932 does not describe fusion proteins comprising a zinc finger binding domain, and a cleavage half-domain, where the zinc finger binding domain is closer to the C-terminus, and the cleavage half-domain is closer to the N-terminus. Throughout Application No. 10/912,932, the fusion proteins are described as having an N-terminal zinc finger binding domain and a C-terminal cleavage domain (e.g., page 43, line 16 to page 44, line 8; page 45, lines 21-31; page 81, lines 16-21; page 84, lines 26-31; Figures 2, 8, 14, 20 and 21).

Provisional Application No. 60/542,780 does not describe fusion proteins comprising a zinc finger binding domain, and a cleavage half-domain, where the zinc finger binding domain is closer to the C-terminus, and the cleavage half-domain is closer to the N-terminus. Throughout Provisional Application No. 60/542,780, the fusion proteins are described as having an N-terminal zinc finger binding domain and a C-terminal cleavage domain (e.g., page 35, line 30 to page 36, line 22; paragraph bridging pages 69-70; page 73, lines 6-11; Figures 2, 8 and 14).

Provisional Application No. 60/556,831 does not describe fusion proteins comprising a zinc finger binding domain, and a cleavage half-domain, where the zinc finger binding domain is closer to the C-terminus, and the cleavage half-domain is closer to the N-terminus. Throughout Provisional Application No. 60/556,831, the fusion proteins are described as having an N-

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terminal zinc finger binding domain and a C-terminal cleavage domain (e.g., page 37, line 22 to page 38, line 14; page 39, line 21 to page 40, line 4; paragraph bridging pages 71-72; page 75, lines 6-11; Figures 2, 8 and 14).

Provisional Application No. 60/575,919 does not describe fusion proteins comprising a zinc finger binding domain, and a cleavage half-domain, where the zinc finger binding domain is closer to the C-terminus, and the cleavage half-domain is closer to the N-terminus. Throughout Provisional Application No. 60/575,919, the fusion proteins are described as having an N-terminal zinc finger binding domain and a C-terminal cleavage domain (e.g., paragraph bridging pages 39-40; page 40, lines 6-22; page 41, line 29 to page 42, line 12; paragraph bridging pages 75-76; page 79, lines 10-15; Figures 2, 8 and 14).

Accordingly, claims 1-14 have an effective filing date of 2/3/2005, which is the filing date of PCT/US05/03245.

### ***Specification***

The abstract of the disclosure does not commence on a separate sheet in accordance with 37 CFR 1.52(b)(4). A new abstract of the disclosure is required and must be presented on a separate sheet, apart from any other text. In the amendment filed 8/10/2010 the abstract was not presented on a separate sheet.

The disclosure is objected to because of the following informalities:

The amendment filed 8/10/2010 contains an incorporation by reference statement added after the application's filing date, where the prior applications are incorporated by reference "in

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their entireties for all purposes." An incorporation by reference statement added after an application's filing date is not effective because no new matter can be added to an application after its filing date (see 35 U.S.C. 132(a)).

Appropriate correction is required.

### ***Conclusion***

Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 25 USPQ 74, 453 O.G. 213, (Comm'r Pat. 1935).

A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer Dunston whose telephone number is (571)272-2916. The examiner can normally be reached on M-F, 9 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on 571-272-0951. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

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like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jennifer Dunston/  
Primary Examiner  
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